

REMARKS

The application was filed on 30 March 2001 with twelve claims. The Examiner examined the application and on 24 March 2005 issued a first Action. In the Examiner's Action, the Examiner rejected claims 5, 6, 8, 9, and 12 under 35 U.S.C. §112, second paragraph. The Examiner also rejected claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,765,138 entitled APPARATUS AND METHOD FOR PROVIDING INTERACTIVE EVALUATION OF POTENTIAL VENDORS to Aycock et al. (Aycock '138), claims 2, 3, 7-11 under 35 U.S.C. §103(a) as being unpatentable over Aycock '138; and claims 5, 6 and 12 under 35 U.S.C. §103(a) over Aycock '138 in view of U.S. Patent No. 5,627,973 entitled METHOD AND APPARATUS FOR FACILITATING EVALUATION OF BUSINESS OPPORTUNITIES FOR SUPPLYING GOODS AND/OR SERVICES TO POTENTIAL CUSTOMERS to Armstrong (Armstrong '973). Applicants responded by amending the claims, cancelling claims 10-12 and adding new claims 13-20.

The Examiner responded on 07 October 2005 by maintaining the rejection of claims 6 and 9 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further issued new rejections of claims 1-9 and 13-20 under 35 U.S.C. §112, 1<sup>st</sup> paragraph; and 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter, setting forth the test that the claimed invention does not produce a useful, concrete, and tangible result.

In response, Applicants amend claims 1, 6, 7, and 9, and remove an abbreviation from the other claims. Claims 1-9, 13-20 are pending.

*The Rejection of claims 1-9 and 13-20 under 35 U.S.C. §112, 1<sup>st</sup> and 2<sup>nd</sup> ¶s*

The Examiner rejected claims 1-9 and 13-20 under 35 U.S.C. §112, both first and second paragraphs. Applicants will address the claims under both paragraphs of 35 U.S.C. §112 because the base of the rejections is the same.

The Examiner states she/he does not understand how results from the matrix are combined with the results from the questions in a way to make recommendations. In response, Applicants refer the Examiner to the specification at page 10, line 20 through page 11, line 14, to figure 4 of Applicants' Drawing which illustrates pertinent questions, and to figure 5 of the Drawing which provides a matrix. At page 11, line 8 of the specification, Applicants state "[t]he answers to the questions will lead the assessment to a determination of the level of maturity as well as identifying areas for improvement." Thus, answers to the questions relating to a service attribute (questions of Figure 4), in this case the definition and understanding of service, determine at what level of maturity that particular service attribute is perceived by the customer (the matrix of Figure 5). In particular and as only one example of how the answers to the questions and the results from the matrix can be combined to create recommendations, Applicants direct the Examiner's attention to the specification at page 11, lines 9-12 which continues the quoted specification above, "[f]or example, if there is a disagreement on the scope of the service between the provider and the customer, it will be hard to have a mature service and the remedy suggested may be that the provider and the customer agree on the scope of the service and document it." Again, the specification at page 11, line 20 through page 12, line provides still additional enablement of how results of the matrix and results of the questions may be combined to provide recommendations: "[a] comparison of the 'now' results with the 'goal' for each service attribute [obtained through questions and recorded on the matrix] can lead quite easily to conclusions about areas for improvement (where the now level of service is less than the goal level of service) as well as areas for possible economy (where the now level of service in column 510 exceeds the goal level of service in column 520)." Thus, the specification provides the direct and explicit connection between the questions and the matrix, and the claims particularly point out and distinctly claim how the questions and the matrix and their combination can be combined to achieve a tangible result to satisfy the written description and the enablement requirement of

35 U.S.C. §112, first paragraph and the definiteness requirement for the claims of 35 U.S.C. §112, second paragraph.

The Examiner further stated that it was not clear how the matrix indicates customer satisfaction since there is no description of the how the matrix is utilized. Utilization of the assessment tools is described in the specification on page 9, lines 13-16 which state that the matrix (one of the assessment tools) may be used in one of several engagement approaches or types of analyses such as a quick, general assessment, a medium depth assessment, an in-depth, interview-based assessment, and an in-depth, workshop-based assessment. *See* also the specification at page 6, line 14 through page 7, line 2. Thus, one of skill in the art of IT is taught the types of assessments and how they are administered and how the results are captured in the matrices to measure customer satisfaction. In addition, the specification at page 13, lines 8 through 14 states how services are assessed using the selected technique and that the information may be captured through various techniques. Matrices may be more suitable in workshops; questions may be asked. Respectfully, the specification does teach one of ordinary skill in the art of information technology how to utilize a matrix as presented and, in light of the specification, the claims particularly point out and distinctly claim the subject matter of the invention thus satisfying the requirements of both paragraphs of 35 U.S.C. §112.

*The Rejection of claim 1 under 35 U.S.C. §112, 2<sup>nd</sup> ¶*

The Examiner rejected claim 1 because it was not clear how each row can correspond to both an attribute and a maturity level. And if all rows contain both attributes and maturity levels, how can the matrix provide an indication of customer satisfaction; and if all rows pertain to the same attribute or if each row represents each of the attributes. In response, Applicants have amended the claim and now try to claim that along one axis, whether it be a row or column, are the levels of maturity of the information technology service attribute; and along the other axis, whether it be a column or a row, is the particular information technology

service attribute. Respectfully, Applicants request the Examiner withdraw the rejection of claim 1 as being indefinite in view of the amendments.

*The Rejection of claim 7 under 35 U.S.C. §112, 2<sup>nd</sup> ¶*

The Examiner further rejected claim 7 because there was an insufficient antecedent basis for “perceived IT service attribute” in the claim. Applicants have amended claim 7 to overcome the rejection.

The Examiner further rejected claim 7 because it was not clear how one compares a “perceived attribute” with an “established level.” Applicants have amended the claim. Applicants further direct the Examiner to the specification at page 11, lines 8 -14 and in particular 12-14 which states, “[o]ne key aspect to assessing a service is to note the gap between the reality and the perception as seen by the customer and by the provider.” Applicants further refer the Examiner to page 11, lines 20 through page 12, line 5 (quoted above) which provides detail of the comparison. When the claims are read in light of the specification, claim 7 provides adequate teaching and particularly point out and distinctly claim the subject matter of the invention.

*The Rejection of claims 1-9 and 13-20 under 35 U.S.C. §101*

The Examiner also rejected the claims under 35 U.S.C. §101 as directed to non-statutory subject matter that allegedly does not produce a useful, concrete and tangible result. Applicants respectfully traverse. Attorney for Applicants have reviewed the Interim Guidelines for Examination of Patent applications for Patent Subject Matter Eligibility at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf) and Ex parte Carl A. Lundgren, Appeal No. 2003-2088, Application 08/093,516 at <http://www.uspto.gov/web/offices/dcom/bpai/prec/2003-2088.pdf>. Applicants will traverse the rejection by pointing that the claimed invention as a whole accomplishes a practical application in the art of information technology.

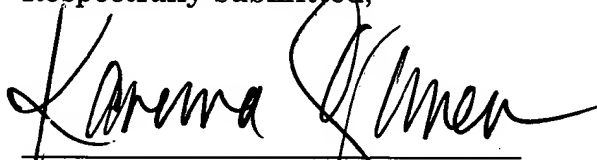
Applicants direct the Examiner's attention to page 10, lines 17-19 which provides an example of a useful, concrete, and tangible result, i.e., the claimed process "determines whether the provider and the customer have a common understanding of the scope and objective of the IT service being provided and to identify any disparity between the expectations." In the art of Information Technology, this is a very useful, concrete, and tangible result. Applicants further direct the Examiner's attention to page 11, lines 9-14 which state that "[t]he answers to these questions will lead the assessment to a determination of the level of maturity as well as identifying areas for improvement. For instance, if there is a disagreement on the scope of the service between the provider and the customer, it will be hard to have a mature service and the remedy suggested may be that the provider and the customer agree on the scope of the service and document it. One key aspect to assessing a service is to note the gap between the reality and the perceptions as seen by the customer and by the provider." In the art of information technology services, not much more can be tangible and useful to a customer. Another example of a tangible, useful, and concrete result provided by the claimed invention is that a "comparison of the 'now' results with the 'goal' for each service attribute can lead quite easily to conclusions about areas for improvement (where the now level of service is less than the goal level of service) as well as areas for possible economy (where the now level of service in column 510 exceeds the goal level of service in column 520)", specification at page 11, line 20 through page 12, line 1 (emphasis added). The claimed invention also provides that "the objectives of the IT organization in delivering its services may become better aligned with the objective of the organization as a whole." *See* specification at page 12, lines 3-4. Certainly, identifying economies of scale and areas for improvement, aligning the delivery of services with the objectives of the organization are real, tangible, and useful consequences in the art of information technology when using the claimed system and method of the invention.

Applicants thus respectfully request the Examiner to reconsider the rejection of the claims under 35 U.S.C. §101 as not reciting statutory subject matter. The procurement of information through the use of particular and sometimes detailed questions coupled with the use of simple and detailed matrices assessing a customer's satisfaction with information technology services and recommending changes to provide a more or less mature level of service is concrete in the world of information technology, certainly is useful, and certainly is tangible.

Conclusion

Having thus amended the claims to remove any indefiniteness of claims 1, 6, 7, and 9, and by pointing out the support in the specification that enable one of ordinary skill in the art to make and use the invention, Applicants have overcome the rejection of the claims under 35 U.S.C. §112, first and second paragraphs. Applicants have further traversed the rejection of the claims under 35 U.S.C. §101 by pointing out how the claimed invention as described in the specification does provide concrete, useful, and tangible results in the world of information technology services. Applicants request the Examiner to allow all claims. The Examiner is further invited to telephone the Attorney listed below if she thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,

  
Karuna Ojanen  
Registration No. 32,484  
507.269.6622 voice

Date: 09 January 2006  
Customer No. 54,462

By

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